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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,935	07/11/2003	Catherine Drogin	465/2	3966

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EXAMINER

COMSTOCK, DAVID C

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/617,935

Applicant(s)

DROGIN ET AL

Examiner

David Comstock

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-6 and 8-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Esker et al. (5,946,773).

Esker et al. disclose a device 10 comprising a sterile blade 12 having a first side 16 and a second side 18 (see Figs. 1-6 and col. 1, lines 4-9). Various ornamental images formed of biocompatible inks appear on both sides 16, 18 of the device and may be multi-colored (id. and see col. 2, lines 25-37 and col. 4, lines 1-16 and 60-63). The images cover substantially all of both sides in various patterns and configurations. It is noted that an image on the first side can be the same as an image on the second side, e.g. a bunch of grapes (see Fig. 3). In addition, an image on the first side, e.g. a bunch of grapes, can be different from an image on the second side, e.g. an apple. The sides 16, 18 of the device can be contacted by a user's tongue. Any portion of the device, including a portion with an image, can be received within a user's mouth due to the biocompatibility of the ink forming the images and an additional biocompatible protective layer (see col. 2, lines 28-48). The device is made of plastic, i.e. styrene, and is protected with a layer of plastic (see col. 2, lines 38-51).

Claims 12, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Daly et al. (910,914).

Daly et al. disclose an unflavored disposable utensil 10 comprising a sterile wooden blade having first and second sides (see Fig. 2; col. 1, lines 30-31, 36-37, 47-49). The first and second sides are received within a mouth and can contact a user's tongue. The device includes ornamental advertising images formed of non-poisonous ink that does not interfere with the hygienic qualities of the utensil (see Fig. 2 and col. 1, line 55 - col. 2, line 3). It is noted that letters and words appeal to children.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 9, 11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esker et al. (5,946,773).

Esker et al. disclose the claimed invention except for the device having the specific size claimed by Applicant. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Esker et al. in any of numerous size, since a mere change in the size of a component is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claims 1-6 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daly et al. (910,914).

Daly et al. disclose the claimed invention except for the device having the specific size claimed by Applicant. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Daly et al. in any of numerous sizes, since a mere change in the size of a component is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Providing multiple colors would have been further obvious since single and multi-color printing are known equivalents in the art at the time of the invention, the difference amounting to nothing more than an obvious choice of design. It also would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate the images so as to have them on both sides of the device, since it has been held that mere duplication of the essential elements of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Moreover, providing different images on each side is merely one of numerous configurations a person of ordinary skill in the art would find obvious. *In re Dailey and Eilers*, 149 USPQ 47 (1966). With regard to claims 9 and 10, Daly et al. do not disclose forming the device from cardboard or plastic. However, it also would have been obvious to one having ordinary skill in the art at the time the invention was made to form the device from cardboard or plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 1-6 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (2004/0109932) in view of Esker et al. (5,946,773).

Chen et al. disclose a tongue depressor, which includes two sides and two tongue contact portions (see paragraphs 0002, 0003, 0063 and 0064). Tongue depressors are sterile. Chen does not disclose providing an ornamental image. Esker et al. disclose a similar device having decorative images formed from biocompatible inks on both sides of the device to make the device attractive and entertaining and to make the device more valuable to the user (see Figs. 1-6; col. 2, lines 25-37; and col. 4, lines 1-16 and 60-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tongue depressor of Chen et al. with decorative images formed from biocompatible inks on both sides of the device, in view of Esker et al., in order to make the device attractive and entertaining and to make the device more valuable to the user. It is noted that providing different images on the two sides would have been an obvious matter of design choice, since applicant has not disclosed that providing the images in this way solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without providing the images in this manner. Moreover, providing different images on each side is merely one of numerous configurations a person of ordinary skill in the art would find obvious. *In re Dailey and Eilers*, 149 USPQ 47 (1966). The sides of the device of the combination of Chen et al. and Esker et al. can be contacted by a user's tongue, and any portion of the device, including a portion with an image, can be received within a user's mouth due to the biocompatibility of the ink forming the images and an additional

biocompatible protective layer (see col. 2, lines 38-48). It also would have been obvious to form this device from wood, plastic, cardboard, or any of numerous other known materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

Applicant's arguments filed 09 May 2005 have been fully considered but they are not persuasive.

In response to applicant's argument pertaining to the intended use of the device with a self-illuminating tongue depressor handle attachment, it is noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). It is noted that the specific way in which the device is intended to be used is not set forth in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In addition, attorney's arguments cannot take the place of evidence in the claims or the

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record. Moreover, a change in the size and dimensions of a device is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). With regard to what is considered to be a decoration on the device, it is noted that letters and words are very appealing to many children. It is further noted that Applicant apparently recognized this obvious point in the specification where it is explained that the ornamental image can be "*any known image or writing, including, but not limited to, patterns, images, cartoon characters, corporate logos, advertising messages [as in Daly et al.], or any other image that is appealing to children.*" (Page 7, lines 27-29, *emphasis added.*)

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Here, it is beyond dispute that decorating something makes the device more attractive and entertaining; it is not necessary to refer to applicant's disclosure to "discover" this. However, such a basic point does not even need to be made since Esker provides the motivation to combine as already set forth in the citations and reasoning in the rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock
21 August 2005



EDUARDO C. ROBERT
PRIMARY EXAMINER